



06-06-03

3/1639
#5
JUN 11 2003
RECEIVED
TECH-CENTER 1600/2900
M.M.
6/18/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wang et al.
Serial No.: 09/767,538
Filed: January 23, 2001
For: ARRAYS FOR BRINGING TWO OR MORE REAGENTS IN CONTACT
WITH ONE OR MORE BIOLOGICAL TARGETS AND METHODS FOR
MAKING AND USING THE ARRAYS

Examiner: Maurie Garcia. Baker, Ph.D.
Group: 1639
Docket No. 17281/00002

Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Washington, DC 20231

RESPONSE

This is a Response to the Office Action dated March 5, 2003 in the subject application.

The Applicant appreciates the Examiner's examination of the application and requests consideration and allowance based on the following remarks and elections.

The Examiner is requiring several levels of restrictions. The first level of election is between four groups as designated by the Examiner. In response, of these four groups, the Applicant elects Group III, which includes claims 37-49 as designated by the Examiner. Within Group III, the Examiner is further requiring the Applicant to elect one of the reagents set forth in claim 39. In response, the Applicant respectfully traverses the restriction because the type of reagent does not affect the structure or mode of action or the mechanisms of the method of claim 37 from which claim 39 depends. The Examiner has stated broadly that the species are in part distinct because "they would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them out".

However, with regard to the method of claim 37 from which 39 depends, the steps and elements

as claimed would be the same for all of the reagents. In addition, the Examiner has not stated how any difference, if any, regardless of the smallest extent of difference, of reactivity or starting materials between the reagents would render each separate reagent as separately patentable. For example, whether the reagent is DNA, RNA, or protein, the method would be the same. The Examiner has not provided any specific example to which the Applicant may respond. In the event, the Examiner continues the restriction with regard to electing one reagent among those listed in claim 37, the Applicant elects DNA.

Also within Group III, the Examiner is requiring a restriction between the types of barriers, namely, the capillary tubes of claims 40-42 and the supports of claims 43-45, based on the same broadly stated reasons for the restriction between the reagents of claim 39. In response, the Applicant respectfully traverses the restriction. All of claims 40-45 depend from the method of claim 37 and do not add any further steps to the method. Although claims 40-45 narrow the scope of the broadly claimed elements of claim 37 from which claims 40-45 depend, the types of barriers specified in claims 40-42 and 43-45, namely, capillary tubes and supports, respectively, do not require such disparate structure or mode to create significantly different issues of patentability. In the event, the Examiner continues the restriction with regard to electing one type of barrier, the Applicant elects the barrier of claims 43-45.

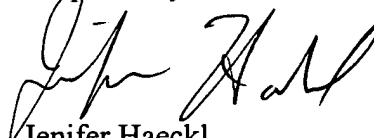
Also within Group III, the Examiner is requiring a restriction between the types of “contacting”, namely, the “seeding and adhering” of claims 46-47 and the “applying conditions” of claims 48-49. It is not clear what restriction the Examiner is seeking because not all of these four claims are directing the step of contacting. Specifically, claim 46 is directed at the step of “providing” and depends directly from claim 37, while claims 47 and 48 are directed at the step

of contacting which also each separately depend directly from claim 37, and claim 49 is directed at the step of applying first recited in claim 48 from which claim 49 depends. In response, the Applicant respectfully traverses this election based on presumption that the Examiner is requiring an election between the step of contacting of claim 47 and the step of contacting of claims 48 and 49. Claim 47 requires that the step of contacting *comprise* the step of seeding and adhering, while claim 48 requires that the step of contacting *comprise* the step of applying one or more conditions. As such, the methods of claims 47 and 48 and their recited sub steps are not exclusionary of the other. However, in the event the Examiner continues the restriction with regard to the step of contacting in claims 47 and in claims 48-49, the Applicant elects claims 48-49.

Each of the Examiner's election requirements has been addressed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and favorable action is requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned in Westborough, Massachusetts at (508) 898-1501.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jenifer Haeckl', is written over the printed name.

Jenifer Haeckl
Reg. No. 41,812